

Appln No. 09/866,546
Amdt date June 6, 2005
Reply to Office action of April 4, 2005

REMARKS/ARGUMENTS

In the final Office action dated April 4, 2005, claims 14 and 20 were objected to, claims 3 - 8 were rejected under 35 U.S.C. § 112, and claims 1 - 20 were rejected under 35 U.S.C. § 103. Claims 1 - 20 remain pending in the application. Reconsideration of the rejections and reexamination of this application are hereby requested.

Response to the Objection to Claims 14 and 20

Applicant has amended claims 14 and 20 as suggested by the Examiner. As this is a minor amendment that does not materially affect the scope of the claims Applicant respectfully requests that this amendment be entered even though the application is under final rejection.

Response to the Rejection of Claims 3 - 8 Under 35 U.S.C. § 112.

Claims 3 - 8 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office action stated that the terms "Bluetooth" and "HomeRF" in claims 3 - 8 are trademarks or trade names that are used to identify/describe different types of operating systems and software application. In this regard the Office action cites MPEP 2173.05(u) and *Ex parte Simpson*, 218 U.S.P.Q. 1020 (Bd. App. 1982). The Office action also stated that the use of the term "802.11b" in claims 6 - 8 create an indefinite situation on the grounds that standards are always subject to interpretations and are constantly being updated.

Appln No. 09/866,546

Amdt date June 6, 2005

Reply to Office action of April 4, 2005

Applicant respectfully traverses the rejection of the claims based on MPEP § 2173.05(u) and *Ex parte Simpson*. The MPEP makes clear that under certain circumstances it is permissible to use a trademark in a claim. See the first sentence in MPEP 2173.05(u). Also see MPEP § 608.01(v) which states in part:

Names used in trade are permissible in patent applications if:

(A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or

(B) In this country, their meanings are well-known and satisfactorily defined in the literature.

Applicant notes that paragraph (A) acknowledges that a trademark may be used in a claim. In addition, paragraph (B) states that the use is permissible when the meaning is well-known and is "satisfactorily defined in the literature."

MPEP 2173.05(u) is directed to the specific use of a trademark that is not permitted under the rule set forth in *Ex parte Simpson*. *Ex parte Simpson* prohibits use of a trademark where a product in the claim is only identified by a trademark yet the composition of that trademarked product could not be ascertained. Specifically, the rejection in *Ex parte Simpson* dealt with the situation where there was no writing that could confirm which additives would be contained a product sold under the trademark "Hypalon." Based on this, the court found that

Appln No. 09/866,546

Amdt date June 6, 2005

Reply to Office action of April 4, 2005

the use of the trademark was improper. *Ex parte Simpson* does not, however, prohibit any other use of a trademark in a claim.

In contrast with the situation in *Ex parte Simpson*, claims 3 - 8 are directed to published standards, not to mere trademarked product names. That is, Bluetooth and HomeRF do not refer to a material or product as was the subject of *Ex parte Simpson* (and discussed in MPEP 2173.05(u)). Rather, they refer to published standards that are well known and are extensively defined in the literature, namely the standards themselves. Given that the standards are well known and adequately defined, the use of the standards in claims 3 - 8 is in compliance with MPEP § 608.01(v).

The Patent Office's practices further support the position that Applicant's use of Bluetooth and HomeRF are acceptable. First, while the MPEP addresses improper trademark usage in at least two sections, it does not state that the recitation of a standard where that standard name may be trademarked is improper. Moreover, as noted in Applicant's Amendment filed on March 7, 2005, the Office has issued hundreds of patents that have claims that recite wireless standards. Indeed, even the Nevo et al. patent cited by the Examiner includes claims that recites standards. These practices are consistent with Applicant's position that the trademark use in claims 3 - 8 is permitted by MPEP § 608.01(v) and is different than the use prohibited by MPEP 2173.05(u) and *Ex parte Simpson*.

Applicant also respectfully traverses the contention in the Office action that standards are indefinite on the grounds that they are subject to interpretation and changes. The sole

Appln No. 09/866,546

Amdt date June 6, 2005

Reply to Office action of April 4, 2005

purposes of the standards recited in claims 3 - 8 are to assure functional connection compatibility of communication equipment so that a wide variety of communication equipment that supports the standard may communicate with one another. It is imperative that for such standards to be effective (and Applicant submits that there is no dispute that they are effective) that the essential requirements addressing the functional criteria for signal transmission compatibility remain unchanged. This is necessary to ensure that equipment originally designed to operate with other equipment that meet the standard will continue to do so as long as the standard is in existence. In view of the above, any interpretation or modification must be of such a minor character that it does not affect the operation of the device as it pertains to meeting the standard. Hence, such minor interpretations or modifications cannot serve as a basis for making the standard indefinite. Thus, the very nature and purpose of the standard, to maintain compatibility between devices, ensures that one skilled in the art will understand the meets and bounds of a "network that operates in accordance with the [Bluetooth, HomeRF or 802.11b] standard" as claimed. In view of the above, Applicant submits that the 35 U.S.C. § 112 rejections of claims 3 - 8 should be withdrawn.

Response to the § 103 Rejection of Claims 1, 2, 9-11 and 15-17

Claims 1, 2, 9 - 11 and 15 - 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Devon, U.S. Patent No. 5,546,211. Claims 1 and 2 are independent claims.

Appln No. 09/866,546

Amdt date June 6, 2005

Reply to Office action of April 4, 2005

Claims 1 and 2 stand rejected, in part, on the grounds that "Devon teaches RF networks provide relatively high data rates over long distances" and it would therefore have been obvious "to combine all of the teachings of Devon to perform the above method with wireless RF networks for the benefit of providing relatively high data rates over relatively long distances."

Applicant submits that Devon's reference to RF systems in fact teach away from the modification suggested by the Examiner. Devon discusses RF systems at column 1, lines 14 - 39 to provide a background as to why the use of IR systems is preferable to RF system. Devon then discusses a protocol selection technique that may be used in an IR system. Devon does not, however, state that such a technique may also be employed in an RF system.

Given that Devon was fully aware of RF systems yet failed to suggest that the IR technique may be used in RF systems, if any inference is to be taken from Devon's discussion of RF systems, that inference would most logically be that such a technique would not be applicable to RF systems. In any event, Devon's silence in this regard cannot serve as the basis for a proactive teaching that the IR technique may be used in RF systems.

In view of the above, Applicant submits that Devon does not teach or suggest all of the limitations of independent claim 1 or independent claim 2. Claims 9 - 11 and 15 - 17 that depend on claims 1 and 2, respectively, also are patentable over the cited references for the reasons set forth above. In addition,

Appln No. 09/866,546

Amdt date June 6, 2005

Reply to Office action of April 4, 2005

these dependent claims are patentable over these references for the additional limitations that the dependent claims contain.

Response to the § 103 Rejection of Claims 3-8, 12-14 and 18-20

Claims 3, 5, 6, 8, 12 - 14 and 18 - 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Devon in view of Nevo et al., U.S. Patent No. 6,600,726 ("Nevo"). Claims 4 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Devon and Nevo in view of Hollstrom et al., U.S. Patent Application Publication No. 2001/0056502 ("Hollstrom"). Claims 3, 4, 6 and 7 are independent claims.

There is no teaching in the art to combine the cited references in a manner that provides the inventions of independent claims 3, 4, 6 and 7. As discussed above in conjunction with Applicant's response to the rejections of independent claims 1 and 2, Devon does not teach or suggest that its IR techniques are applicable to RF system. The other references also are silent in this regard. Hence, there is no evidence that one skilled in the art would have looked to Devon for improvements to RF systems or that one skilled in the art would have been motivated to modify the Devon to be used in an RF system.

Moreover, it would not have been obvious to apply the sequential teachings of Devon to the systems of Nevo. As discussed in Applicant's last response, Nevo discloses techniques that may be used during simultaneous communication with two networks. See, for example, Nevo at column 4, lines 13 - 15. Given these significantly different architectures, one

Appln No. 09/866,546

Amdt date June 6, 2005

Reply to Office action of April 4, 2005

skilled in the art would not have been motivated to combine the two systems. Moreover, there is no teaching as to how such a combination would be achieved at all, much less in a manner that would provide the invention of claims 3, 4, 6 and 7.

In view of the above, there is no teaching or suggestion that "sequentially performing network scans in accordance with the Bluetooth standard and network scans in accordance with the HomeRF standard" may be used in "selecting a network" and "establishing a connection with the selected network" as claimed in claims 3 and 4. Similarly, there is no teaching or suggestion that "sequentially performing network scans in accordance with the Bluetooth standard and network scans in accordance with the 802.11b standard" may be used in "selecting a network" and "establishing a connection with the selected network" as claimed in claims 6 and 7.

Claims 5 and 8 that depend on claims 4 and 7, respectively, and claims 12 - 14 and 18 - 20 that depend on claims 1 and 2, respectively, also are patentable over the cited references for the reasons set forth above. In addition, these dependent claims are patentable over these references for the additional limitations that the dependent claims contain.

Appln No. 09/866,546

Amdt date June 6, 2005

Reply to Office action of April 4, 2005

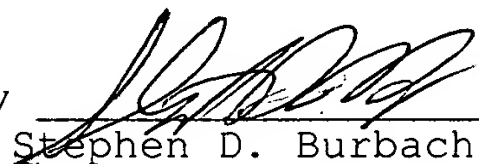
CONCLUSION

For the foregoing reasons Applicant submits that the claims are patentable over the references of record. Reexamination and reconsideration are respectfully requested.

Respectfully submitted,

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